Appl. No. .: 10/625,999
Amendment Dated August 9, 2006
Response to Office Action Mailed May 9, 2006

Express Mailing Label:
EV 873497543 US

REMARKS

A.   GENERALLY

Claims 1-7, 9-20, 22-43, 63-78 remain in this application. Claims 1-7, 9-20, 22-29, 33-38, 42-43, and 63-74 have been amended. Claims 8, 21, and 44-62 have been canceled. Claims 75-78 have been added.

Paragraph 0041 of the Specification has been amended to correct a typographical error. No new matter has been added.

Applicant wishes to thank the examiner for extending the courtesy of an interview on July 18, 2006. Applicant has provided a summary of the interview herewith.

B.   CLAIM REJECTIONS

Claim Rejections under 35 U.S.C. §112

Claims 1-26 and 63-74 have been rejected under 35 U.S.C. §112, second paragraph, for making reference to multiple statutory classes of invention. Applicant has removed the structural references from the preambles of the rejected claims so as to clearly identify the claims as method claims. Based on these amendments, Applicant respectfully submits that claims 1-26 and 63-74 particularly point out and distinctly claim Applicant's invention.

Claim Rejections under 35 U.S.C. §102(e)

Claims 1-3 as originally filed have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,978,273 issued to Bonneau (herein, "Bonneau").

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (MPEP §2131, 8th Ed. (Rev. 1).)

Claim 1 (as amended) of the present application recites the following limitations:

1. A method for producing a customized catalogue comprising pages for a catalogue retailer for delivery to a targeted recipient in physical form comprising:

acquiring targeted recipient data, wherein the targeted recipient data comprise historical transaction data specific to the targeted recipient, wherein the targeted

-19-

Appl. No. .: 10/625,999
Amendment Dated August 9, 2006
Response to Office Action Mailed May 9, 2006

Express Mailing Label:
EV 873497543 US

recipient data are updated periodically, and wherein the historical transaction data relate to transactions between the targeted recipient and the catalogue retailer;

creating a targeted recipient profile from the targeted recipient data;

applying a set of offering rules to the targeted recipient profile to select an offering from offerings stored in an offerings database;

acquiring a set of product assets associated with the selected offering;

generating a customized catalogue specification file for the targeted recipient using the set of product assets; and

printing the customized catalogue using the customized catalogue specification file.

According the examiner, the following excerpt from Bonneau discloses a method for creating a targeted recipient profile for a buyer using a targeted recipient record of the buyer:

A buyer's custom version of the seller's catalog consists of a subset of the items in the catalog database, the scope of which has been predefined for each buyer. The scope of each subset of items, and therefore the scope of each custom version of the catalog, is precisely defined by a set of rules that is developed and assigned to each buyer. Each set of rules is associated with a unique identifier, and each buyer is assigned to one set of rules through its associated identifier. Those of skill in the art will recognize that some buyers will have common product or service interests and therefore will share the same customized catalog, and thus will be assigned to the same set of rules by a common identifier. Each set of rules constrains a search of the database based on a product type and a set of attribute values, and when the search is executed returns a set of SKUs from the catalog database. Each SKU number identifies a unique item consisting of a unique set of attribute values. (Bonneau, Col. 4, lines 36-53; emphasis added by underlining.)

Applicant respectfully submits that the cited language does not teach or disclose the limitations, "acquiring targeted recipient data, wherein the targeted recipient data comprise historical transaction data specific to the targeted recipient, wherein the targeted recipient data are updated periodically, and wherein the historical transaction data relate to transactions between the targeted recipient and the catalogue retailer" and "creating a targeted recipient profile from the targeted recipient data," as recited in claim 1 (as amended) of the present application. The cited language discloses a manual process for acquiring customer-related data to create a set of search criteria (rules). However, the data used to create these rules are not "historical transaction data" but are preferences that are acquired by human interaction with a terminal:

FIGS. 6a-6h illustrate screen shots produced by the application on a seller-authorized user's web browser by which a rule set is developed for a fictitious extranet buyer or list of buyers called Sellco, the process which is initiated by activating the "Create Subset"

Appl. No. .: 10/625,999
Amendment Dated August 9, 2006
Response to Office Action Mailed May 9, 2006

Express Mailing Label:
EV 873497543 US

button as shown in FIG. 6a. In this case, FIG. 6a illustrates that a catalog subset has already been created for Sellco. By selecting Sellco and catalog subsets, the Sellco rule set is displayed in FIG. 6b. The terms "Show" and "Hide" are used interchangeably with the terms "Include" and "Exclude" as used hereinabove. To add to the rule set already created, the user selects the "Add Rule" button as shown on FIG. 6b. FIG. 6c shows the first option for creating the rule is to select between "Hide" or "Show" to create the next rule. FIG. 6d shows that "Hide" was selected, and now a product type is selected from the drop-down list box, from which "CD Player" is selected. FIG. 6e illustrates that a Vendor attribute can be optionally selected from the drop down list. FIG. 6f illustrates that upon activating (i.e. clicking on) the "Refine" button, additional attributes unique to the product type can also be selected from a drop down list. FIG. 6g illustrates that the "Availability" attribute has been chosen, and the attribute operator can be selected from a drop down list and a value inserted in the text box to the right of the operator. Finally, FIG. 6h illustrates that another buyer can be associated with a set of rules. (Bonneau, Col. 12, lines 19-44.)

Even if the rule set created by the process in Bonneau could be construed as a "profile" in a general sense, it is not a profile of a targeted recipient as that term is used in the present application. In contrast to Bonneau, the present invention relies on an automated process to create a "targeted recipient profile" from data collected from transactions between a merchant and a targeted recipient. Bonneau does not, therefore, teach or describe creating a "targeted recipient profile" as that term is used in the present application because Bonneau does not rely on historical transaction data relating to transactions between the targeted recipient and the catalogue retailer to generate rules for selecting products from a product inventory.

Additionally, Bonneau does not disclose the limitation, "printing the customized catalogue using the customized catalogue specification file" recited in claim 1 (as amended). Bonneau is directed to electronic catalogs, not printed catalogs. This is made clear in the discussion of the prior art. (See, Bonneau, Col. 1, line 1 through Col.2, line 67.) When Bonneau refers to a "physical manifestation," Bonneau is describing electronic files, not printed materials:

> For a seller carrying many different items (or providing many classes and types of services), maintaining even one version of an e-catalog can be extremely difficult. To maintain several custom versions of an electronic catalog, a physical manifestation of each custom version is typically created and each version must be maintained and updated as the catalog data changes. Each time a product or service is added, or its attributes or attribute values are changed, every physical manifestation of a version of the catalog must be individually updated to ensure that each version reflects the changes in the catalog data. Each version essentially is obsolete until updated.

> Although each version of an electronic catalog is maintained by computer, the fact that an update must be performed for each existing version of the catalog can be time-

Appl. No. .: 10/625,999
Amendment Dated August 9, 2006
Response to Office Action Mailed May 9, 2006

Express Mailing Label:
EV 873497543 US

consuming, labor intensive and prone to error. Moreover, updating multiple versions of the catalog is made even more onerous because they typically reside at different physical locations, to many of which the seller has no direct access. For example, <u>some versions of the catalog may have been published to buyers' proprietary retail web sites, some to public marketplace web sites and still other versions to procurement networks</u>. (Bonneau, Col. 2, lines 7-31; emphasis added by underlining.)

For the foregoing reasons, Applicant respectfully submits that Bonneau does not teach all of the limitations of claim 1 (as amended) and that claim 1 (as amended) is not anticipated by Bonneau.

Claim 3 (as amended) depends from claim 1 (as amended) recites all of the limitations of claim 1 (as amended). Because claim 1 (as amended) is not anticipated by Bonneau, it follows that claim 3 (as amended) is not anticipated by Bonneau.

<div align="center">Claim Rejections Under 35 U.S.C. §103</div>

Claims 4-74 (as originally filed) have been rejected under 35 U.S.C. §103 as being unpatentable over Bonneau in view of U.S. Patent Application Publication No. 2002/0143603 filed by Moore ("Moore").

To establish a prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP §2143.03, 8th Ed. (Rev. 2, 2004). Further, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP §2143.01, 8th Ed. (Rev. 2, 2004).

Bonneau uses a set of search rules that is manually created for a particular customer to select products from an inventory of products. Moore, on the other hand, requires data from a large sample of customers:

> Referring now to FIG. 4, a flowchart illustrating a method for automated and mass customization of marketing materials is depicted in accordance with the present invention. The process begins with the development of a model to predict whether or not a consumer will purchase a particular product (step 401). This step would be performed by a marketing and data mining group. The data mining could be performed using a program such as Intelligent Miner and possibly a custom data mining program to run Intelligent Miner in batch <u>to generate response models for each product</u>. The model might provide the probability that a customer would buy a particular product or would respond to a particular marketing approach. <u>The next step would be to score all customers for</u>

Appl. No. .: 10/625,999
Amendment Dated August 9, 2006
Response to Office Action Mailed May 9, 2006

Express Mailing Label:
EV 873497543 US

<u>each predictive model (step 402).</u> This step could be performed by an Information Technology (IT) or data mining group. (Moore, ¶ 0031; emphasis added by underlining.)

Thus, Moore contemplates a product-by-product analysis of mined data to determine a number of response models for an individual product. All customers are then scored against each predictive model to determine a probability that a customer will purchase a product if the conditions of the model are implemented. Bonneau does not require knowledge of the behavior of a group of customers and, in fact, teaches against such an approach. Bonneau is directed at searching a database based on criteria that are specific to a customer as determined by that customer (see, Bonneau, Col. 4, lines 36-53, Col. 12, lines 19-44, and Figures 6a-6h). Further, Bonneau would not benefit from the economic analysis of Moore because the electronic catalogs generated by the Moore system are responsive to requests from customers (retail and wholesale). Based on the foregoing, Applicant respectfully submits that there is no motivation to modify Bonneau to accommodate Moore.

It is also well established that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP §2143.01, 8th Ed. (Rev. 2, 2004). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP §2143.01, 8th Ed. (Rev. 2, 2004). Applicant submits that based on the foregoing, combining Bonneau and Moore would render Bonneau unsatisfactory for its intended purpose.

Even assuming that motivation can be found for combining Bonneau with Moore, applicant submits that the combination does not teach or disclose the limitations of the cited claims. Claims 4-7 (as amended), 9-13 (as amended), and 75 depend directly or indirectly from claim 1 (as amended). As previously demonstrated, Bonneau does not teach or disclose the limitations of claim 1. Thus, claims 4-7 (as amended), 9-13 (as amended) and claim 75 recite limitations not taught or disclosed by the combination of Bonneau and Moore.

Independent claims 14 (as amended), 27 (as amended) and 63 (as amended) also recite limitations directed to creating a "targeted recipient profile" from data collected from

Appl. No. .: 10/625,999
Amendment Dated August 9, 2006
Response to Office Action Mailed May 9, 2006

Express Mailing Label:
EV 873497543 US

transactions between a merchant and a targeted recipient and using the targeted recipient profile to select an offering. Bonneau does not teach or describe creating a "targeted recipient profile" as that term is used in the present application or selecting an offering from offerings stored in a database through application of offering rules to the targeted recipient profile. The examiner has not cited Moore as teaching these limitations and Moore, in fact, does not teach them. It follows that the claims that depend from independent claims 14 (as amended), 27 (as amended) and 63 (as amended) recite limitations not taught or disclosed by the combination of Bonneau and Moore.

Based on the foregoing, Applicant submits that claims 15-20 (as amended), 22-26 (as amended), and claim 76, which depend directly or indirectly from independent claim 14 (as amended) are not obvious over Bonneau in view of Moore.

Based on the foregoing, Applicant submits that claims 28-29 (as amended), 30-32, 33-38 (as amended), 39-41, 42-43 (as amended), and 77 which depend directly or indirectly from claim 27 (as amended) are not obvious over Bonneau in view of Moore.

Based on the foregoing, Applicant submits that claims 64-74 (as amended) and claim 78, which depend directly or indirectly from claim 63 (as amended), are not obvious over Bonneau in view of Moore.

C.   CONCLUSION

In view of the above information and remarks, Applicant respectfully requests reconsideration of the current rejections. For the above reasons, Applicant respectfully submits that the application is in condition for allowance with claims 1-7, 9-20, 22-43, 63-78. Should any further questions arise concerning this application or in the event the above amendments do not place the application in condition for allowance, Applicant respectfully requests an interview with the examiner and the examiner's supervisor prior to any new office action relating to the present Application. Attorney for the Applicant may be reached at the number listed below. The Director of the U.S. Patent & Trademark Office is authorized to charge any necessary fees, and

Appl. No. .: 10/625,999
Amendment Dated August 9, 2006
Response to Office Action Mailed May 9, 2006

Express Mailing Label:
EV 873497543 US

conversely, deposit any credit balance, to Deposit Account No. 18-1579.

Respectfully Submitted,

By

Jon L. Roberts, Esq.
Registration No. 31,293
Elliott D. Light, Esq.
Registration No. 51,948
Roberts Mardula & Wertheim, LLC
11800 Sunrise Valley Drive, Suite 1000
Reston, VA 20191
703-391-2900